

**Remarks/Arguments:**

**Introduction**

Claims 1, 3, 5-10, 13, 14 and 16 are pending assuming entry of the proposed amendments. Claim 1 has been amended to include the limitations of claims 5 and 15. Claims 5 and 15 are canceled.

No new matter is introduced with these amendments. Entry of the amendments is respectfully requested.

**Section 102 Rejections**

Claims 1, 3, 7-10 and 16<sup>1</sup> rejected under 35 U.S.C. §102(b) as allegedly being anticipated by JP 08005563 to Kinoshita et al. (hereinafter "Kinoshita"). Applicant respectfully traverses.

Kinoshita fails to disclose the inspection device of the present invention as defined by independent claim 1 which comprises, *inter alia*, a box having a mirroring surface consisting essentially of four reflective side wall mirrors having a coefficient of reflection of at least 0.8, where the four reflective side wall mirrors are side walls that define the box. Firstly, Kinoshita merely describes the use of reflective paint "a" to its wall "1a" at paragraph [0009], line 3. The examiner alleges that any paint may be used as Kinoshita's reflective paint "a", and, in particular, the examiner asserts that "chrome paint" may be used at page 2 of the Action.

It is respectfully that that Kinoshita fails to disclose chrome paint and fails to disclose four reflective side wall mirrors having a coefficient of reflection of at least 0.8. As Kinoshita

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<sup>1</sup> It is assumed that these noted claims are rejected under Section 102(b) as discussed in detail in the paragraphs of section 6 of the Office action as contrasted to the listing of claims in the introductory paragraph of section 6.

is silent as to whether its "reflective paint" may be a chrome paint as asserted by the examiner or may be a paint having a coefficient of reflection of at least 0.8, the Examiner must then properly apply an inherency argument to the missing descriptive matter of Kinoshita. To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *Crown Oper. Int'l Inc. v. Solutia Inc.*, 289 F.3d 1367, 62 U.S.P.Q.2d 1917 (Fed. Cir. 2002). Further, inherency may not be established by probabilities or possibilities, and the mere fact that a certain thing may result from a given set of circumstances is not sufficient for a *prima facie* case of anticipation. *Scaltech Inc. v. Retec/Tetra L.L.C.*, 153 F.3d 1193, 51 U.S.P.Q.2d 1055 (Fed. Cir. 1999). Occasional results are not inherent. *Mehl/Biophile Int'l Corp. v. Milgraum*, 192 F.3d 1365, 52 U.S.P.Q.2d 1303, 1306 (Fed. Cir. 1999).

Thus, Kinoshita fails to disclose an inspection device comprising, *inter alia*, a box having a mirroring surface consisting essentially of four reflective side wall mirrors having a coefficient of reflection of at least 0.8, where the four reflective side wall mirrors are side walls that define the box, as set forth in independent claim 1.

Further, Kinoshita fails to disclose the inspection device of the present invention as defined by independent claim 1 which comprises, *inter alia*, a light source having a substantially even light plane directed towards the inside of the box, and which light source, as a result of the mirroring side walls, recurs on all sides so as to provide uniform illumination of the objects on the conveyor from all sides. The light source 9 of Kinoshita is directed towards only a portion of its side walls and top wall above the light source 9. (See, Kinoshita, Fig. 2). As shown in Fig. 2 of Kinoshita its light rays do not have a "substantially even light plane directed towards the inside of the box, as set forth in independent claim 1. Moreover, the mirrors 7 of Kinoshita cannot be considered to be the mirroring side walls of the present invention as asserted by the examiner. Indeed, the Examiner specifically states that the "the

reflecting plates 7 [of Kinoshita], such as mirrors, is not different from a part of the side walls" at page 3 of the Action. Clearly, in Fig. 2 of Kinoshita the mirrors 7 are not depicted as being part of the side walls 2 of Kinoshita. Thus, Kinoshita fails to disclose each and every limitation as claimed in independent claim 1.

Moreover, as described above, the inspection device of the present invention comprises, *inter alia*, a box having a mirroring surface consisting essentially of four reflective side wall mirrors. The required four side walls 2 and four mirrors 7 of Kinoshita clearly do not read on the present invention. To be of any use to the Examiner, the four mirrors 7 of Kinoshita must be part of its side walls 2. Kinoshita, however, fails to disclose such a configuration. As Kinoshita is silent to the proposed structure offered by the Examiner, the Examiner must then properly apply an inherency argument to the missing descriptive matter of Kinoshita. To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *Crown Oper. Int'l Inc. v. Solutia Inc.*, 289 F.3d 1367, 62 U.S.P.Q.2d 1917 (Fed. Cir. 2002). Further, inherency may not be established by probabilities or possibilities, and the mere fact that a certain thing may result from a given set of circumstances is not sufficient for a *prima facie* case of anticipation. *Scaltech Inc. v. Retec/Tetra L.L.C.*, 153 F.3d 1193, 51 U.S.P.Q.2d 1055 (Fed. Cir. 1999). Occasional results are not inherent. *Mehl/Biophile Int'l Corp. v. Milgraum*, 192 F.3d 1365, 52 U.S.P.Q.2d 1303, 1306 (Fed. Cir. 1999). Thus, Kinoshita fails to disclose each and every limitation as claimed in independent claim 1.

Additionally, Kinoshita directs light from its light sources 9 to four side walls and to one top wall having reflective paint. This is clearly depicted in the figures of Kinoshita. Thus, even excluding any consideration toward the four mirrors 7 of Kinoshita, the device of Kinoshita has at least five reflective surfaces, i.e., four side walls and one top ceiling. This is

in direct contrast to the present invention which claims, *inter alia*, a box having a mirroring surface consisting essentially of four reflective side wall mirrors.

Still further, Kinoshita fails to disclose the inspection device of the present invention as defined by independent claim 1 which comprises, *inter alia*, a conveyor adapted to convey a plurality of objects placed next to each other in a direction transverse to the conveying direction and a light source, as a result of the mirroring side walls, recurs on all sides so as to provide uniform illumination of the objects on the conveyor from all sides. Kinoshita shows a single line of objects "A" traveling through its device in Figs. 1, 3 and 4. Assuming, *arguendo*, that two or more objects "A" of Kinoshita could be placed next to each other in a direction transverse to the conveying direction, Kinoshita's mirrors 7 are not configured to direct reflections from between juxtaposed surfaces of transversely disposed objects "A" toward its camera 6. In other words, Kinoshita fails to disclose the device as claimed. As described above, under a Section 102 rejection a reference must disclose, either explicitly or inherently, all of the claimed features. To establish inherency for any missing description, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *Crown Oper. Int'l Inc. v. Solutia Inc.*, 289 F.3d 1367, 62 U.S.P.Q.2d 1917 (Fed. Cir. 2002). Further, inherency may not be established by probabilities or possibilities, and the mere fact that a certain thing may result from a given set of circumstances is not sufficient for a *prima facie* case of anticipation. *Scaltech Inc. v. Retec/Tetra L.L.C.*, 153 F.3d 1193, 51 U.S.P.Q.2d 1055 (Fed. Cir. 1999). Occasional results are not inherent. *Mehl/Biophile Int'l Corp. v. Milgraum*, 192 F.3d 1365, 52 U.S.P.Q.2d 1303, 1306 (Fed. Cir. 1999). Thus, Kinoshita fails to disclose each and every limitation as claimed in independent claim 1.

Thus, Kinoshita fails to disclose the invention as presently defined by claim 1. Reconsideration and withdrawal of the Section 102 rejection of claim 1, and all claims dependent therefrom, are respectfully requested.

### **Section 103 Rejections**

A) Claim 6 is rejected under 35 U.S.C. §103(a) as allegedly being obvious over Kinoshita in view of U.S. Patent No. 1,947,142 to W. J. Ward et al. (hereinafter "Ward"). Applicant respectfully traverses.

Ward discloses an apparatus for the inspection of eggs on a conveyor. From Figs. 6-8 it is clear that illumination occurs from below, and a lens is provided above the eggs for better inspection. No box having just four mirroring side walls is disclosed, taught or suggested. The examiner refers to Fig. 3 directed to the inspection of bottles, in which the lights are mounted on a metal wall 20 of cabinet 18. However, the cabinet 18 is not a box positioned above the conveyor in which a camera is accommodated, as the conveyor is positioned adjacent the cabinet and no camera is present. Observation of the milk bottles takes place through the lens 14, which is even further remote from the cabinet 18.

Thus, Ward fails to cure the above-described deficiencies of Kinoshita.

Moreover, just replacing the reflectively painted walls of Kinoshita with metal walls of Ward as suggested by the Examiner does not arrive at the present invention. To be of any use of the examiner the four mirrors 7 of Kinoshita must be eliminated or disposed directly on its side walls 2. In such a case the reflective side walls 2 of Kinoshita, whether containing the mirrors 7 or devoid of the mirrors 7, do not direct reflections from between juxtaposed surfaces of a plurality of transversely disposed objects "A" toward its camera 6. In other words, the modification of Kinoshita as asserted by the Examiner will destroy the very purpose, function and intent of Kinoshita because the camera 6 could not receive reflections from all sides of the plurality of transversely disposed objects being inspected in the device. An inoperable reference, such as the modified device of Kinoshita as proposed by the examiner, cannot form a basis for a *prima facie* case of obviousness. *In re Gordon et al.*, 221

U.S.P.Q. 1125, 1127 (CAFC 1984). Indeed, such an inoperable device as proposed by the examiner is a direct teaching away from the present invention. *Id.*

Furthermore, the Examiner would have to remove any "mirroring" effect from the top ceiling of Kinoshita in an attempt to arrive at the present invention which comprises, *inter alia*, a box having a mirroring surface consisting essentially of four reflective side wall mirrors. Elimination of the reflective properties for redirecting light of the top ceiling would clearly make the device of Kinoshita inoperable for its intended purpose and function. A top ceiling without reflective properties for redirecting light would prohibit the light from the light sources 9 from reaching its intended targets, i.e., objects "A" in Kinoshita. As depicted in Fig. 3, Kinoshita purposely directs its light from its four light sources only to the upper portions of its four walls and to the upper ceiling in either a direct fashion or an indirect fashion from the upper side walls. Elimination, for the sake of argument, of reflective properties for redirecting light of the top ceiling would necessarily eliminate illumination of the objects "A", thereby making the device of Kinoshita inoperable for its intended purpose. Again an inoperable reference, such as the modified device of Kinoshita as proposed by the examiner, cannot form a basis for a *prima facie* case of obviousness. *In re Gordon et al.*, 221 U.S.P.Q. 1125, 1127 (CAFC 1984). Indeed, such an inoperable device as proposed by the examiner is a direct teaching away from the present invention. *Id.*

Moreover, in establishing a *prima facie* case of obviousness, the cited references must be considered for the entirety of their teachings. *Bausch & Lomb, Inc. v. Barnes-Hind, Inc.*, 230 U.S.P.Q. 416, 419 (Fed. Cir. 1986). It is impermissible during examination to pick and choose from a reference only so much that supports the alleged rejection. *Id.* It is only through hindsight reconstruction and selective picking and choosing while ignoring divergent teachings does the Examiner attempt to reach the present invention through the combination of Kinoshita and Ward. It is also well established, however, that hindsight reconstruction of a reference does not present a *prima facie* case of obviousness, and any attempt at hindsight

reconstruction using Appellant's disclosure is strictly prohibited. *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1445-46 (Fed. Cir. 1993). Such hindsight reconstruction by the Examiner is clear as both Kinoshita and Ward individually fail to teach or suggest the invention as presently defined by independent claim 1.

Therefore, claim 6 is patentably distinct over Kinoshita and Ward. Reconsideration and withdrawal of the rejection of claim 6 is respectfully requested.

**B)** Claims 13 and 14 are rejected under 35 U.S.C. §103(a) as allegedly being obvious over Kinoshita in view of U.S. Patent No. 5,321,491 to Summers et al. (hereinafter "Summers"). Applicant respectfully traverses.

Summers discloses a device for the grading of shell eggs having at least two cameras and a computer. Summers, however, fails to disclose, teach or suggest, *inter alia*, a box positioned above a conveyor as claimed in the subject application.

Thus, Summers fails to cure the above-described deficiencies of Kinoshita. Therefore, claims 13 and 14 are patentably distinct over Kinoshita and Summers. Reconsideration and withdrawal of the rejection of claims 13 and 14 are respectfully requested.

#### Summary

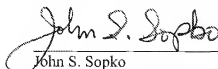
Therefore, Applicants respectfully submit that independent claim 1, and all claims dependent therefrom, are patentably distinct. This application is believed to be in condition for allowance. Favorable action thereon is therefore respectfully solicited.

Should the Examiner have any questions or comments concerning the above, the Examiner is respectfully invited to contact the undersigned attorney at the telephone number given below.

Application No.: 10/577,286  
Amendment and Response dated May 30, 2008  
Reply to Final Office Action of April 2, 2008  
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The Commissioner is hereby authorized to charge payment of any additional fees associated with this communication, or credit any overpayment, to Deposit Account No. 08-2461. Such authorization includes authorization to charge fees for extensions of time, if any, under 37 C.F.R. § 1.17 and also should be treated as a constructive petition for an extension of time in this reply or any future reply pursuant to 37 C.F.R. § 1.136.

Respectfully submitted,

A handwritten signature in dark ink, appearing to read "John S. Sopko", is written over a horizontal line.

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